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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of			
John C. Harvey and James W. Cuddihy		Examiner:	Luther, W.
Serial No.	08/511,491	Group Art Unit:	2731
Filed:	June 6, 1995	Atty. Dkt.	05634.0274
For: **SIGNAL PROCESSING APPARATUS AND METHODS**			

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

REQUEST FOR RECONSIDERATION

This paper is responsive to the Office communication mailed June 8, 2000, by the Patent and Trademark Office (PTO). The communication contends that Applicants' reply filed July 2, 1998 (July 2 Response) was not fully responsive to the prior Office Action. Applicants respectfully request that the Examiner withdraw his objection to the July 2 Response.

The Examiner asserts, in the recent communication that "[t]he reply filed 7/2/98 is not fully responsive to the prior Office action because: applicants deliberately omitted identification of instant support for Section 112 rejections by, inter alia, identifying sentences, paragraphs, and passages that do not exist in the instant disclosure." The Examiner has issued a practically identical statement in another twenty-eight of Applicants' related applications. These

applications are part of a group of 328 continuation applications filed based upon Applicants' application serial no. 08/113,329. Applicants have vigorously prosecuted all of these applications and have filed a full response to every Office Action issued in each of these applications. In late 1998 and early 1999, Applicants conducted a series of interviews with senior PTO examiners to discuss expediting the prosecution of Applicants' co-pending applications. At no time during these interviews did any examiner indicate that any of Applicants' prior responses were not fully responsive. As a result of these interviews, Applicants and the PTO agreed to consolidate Applicants' claims into fewer applications. In accordance with the agreement, 79 actively examined applications remain pending. Another 79 applications remain pending, but are held in reserve with further examination held in abeyance pending final action in the active applications. Nevertheless, the Examiner now contends that prior responses are non-responsive in twenty-nine of the applications Applicants and the PTO agreed would remain pending. Applicants filed the responses to which the Examiner objects between November 26, 1997 and September 29, 1999. Accordingly, the PTO has had from eight to thirty months to consider these responses. This Office communication was issued over twenty-three months after the July 2 Response was filed and after the PTO issued, on May 11, 2000, an Interview Summary expressly stating that an action on the merits is forthcoming. The Examiner has disregarded Section 714.05 of the Manual of Patent Examining Practice which mandates that "[a]ctions by applicants . . . should be inspected immediately upon filing to determine whether they are completely responsive to the preceding Office action so as to prevent abandonment of the application." The Examiner fails to state under what authority he has issued this communication. The Examiner also fails to indicate the intended effect of this communication on the instant application.

Applicants recognize that responses to Office Actions must comply with the requirements of 37 C.F.R. § 1.111(b), which states:

> In order to be entitled to reconsideration or further examination, the applicant . . . must reply to the Office action. The reply by the applicant . . . must be reduced to

> a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. . . . The applicant's . . . reply must appear throughout to be a *bona fide* attempt to advance the application . . . to final action.

Applicants firmly believe that a simple review of the instant application clearly demonstrates the July 2 Response to fully comply with 37 C.F.R. § 1.111. Accordingly, the action by the Examiner is without merit and the instant application is entitled to reconsideration or further examination.

The PTO mailed an Office Action on January 6, 1998. The January 6 Action included, at part 6, a rejection of claims 6-22, 29, 34-37, 40 and 41 under the written description requirement of 35 U.S.C. § 112, first paragraph. The Examiner asserted in the January 6 Action that the claims contain "subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art in the relevant art that the inventor(s), *at the time the application was filed*, had possession of the claimed invention." (emphasis added.) The Examiner included a specific list of claim limitations deemed not to be supported by *the specification as originally filed.* The instant application claims priority under 35 U.S.C. § 120 of the filing date of application serial number 07/317,510 filed November 3, 1981, now issued as U.S. Patent No. 4,694,490. Each claim in the instant application has had an effective filing date of November 3, 1981. Nowhere in the prosecution of the instant application has any Examiner reviewing the application raised any question regarding continuity of disclosure between the parent application filed November 3, 1981, and the instant specification. The July 2 Response includes, in section II.E., a reply to the rejection under the written description requirement of 35 U.S.C. § 112, first paragraph. The response distinctly and specifically points out that the specification as originally filed describes the claim limitations. The response includes detailed and specific references to the parent Patent No. 4,694,490 indicating where each claim limitation is described. The Examiner now asserts that the July 2 Response was not fully responsive because the specific citations are to the parent patent rather than the instant specification.

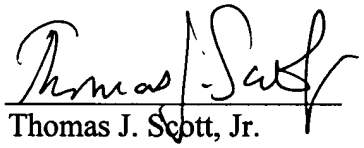
In view of the circumstances described above, Applicants submit that the July 2 response, reciting support from the parent application, is, and does appear throughout to be, a *bona fide* attempt to advance the application to final action. Applicants received a rejection asserting that the application as originally filed fails to convey that Applicants had possession of the claimed invention. Applicants specifically replied to this rejection by demonstrating where the originally filed application described the claim limitations. Applicants submit that the July 2 Response fully complies with 37 C.F.R. § 1.111 and accordingly that the instant application is entitled to reconsideration or further examination.

The Examiner asserts that Applicants deliberately omitted identification of instant support for the Section 112 rejections in the July 2 response. To the contrary, Applicants specifically provided the detailed support deemed best to address the rejection presented in January 6 Action. As the Examiner made no rejection under the enablement requirement of 35 U.S.C. § 112, first paragraph, and the Examiner did not question the continuity of disclosure between the parent Patent No. 4,694,490 and the instant disclosure, there was no specific request to cite support from the instant specification. Applicants did not deliberately omit any information from the July 2 Response, but rather included the arguments and specific citations that distinctly and specifically addressed the rejection presented in the January 6 Action.

The Examiner asserts that since the period for reply set forth in the prior Office Action has expired, this application will become abandoned unless applicants correct the deficiency and obtain an extension of time under 37 CFR 1.136(a). Applicant find this statement particularly disingenuous as the six month statutory period expired July 6, 1998, and in view of the May 11 Interview Summary stating an action on the merits is to follow. Applicants assert for the reasons discussed above that the July 2 response includes no deficiency as asserted by the Examiner. As the July 2 response fully complies with the requirements of 37 C.F.R. § 1.111, this application is entitled to reconsideration or further examination and therefore will not become, and is not, abandoned. Section 707.02(a) of the Manual of Patent Examination provides, "Any application that has been pending five years should be carefully studied by the supervisory patent examiner

and every effort made to terminate its prosecution. In order to accomplish this result, the application is to be considered 'special' by the examiner." As this application has been pending five years, Applicants respectfully request that the Examiner advance this application out of turn for further consideration and promptly issue an action on the merits.

Respectfully submitted,



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John C. Harvey *and* James W. Cuddihy:

Serial No.: 08/511,491

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Group Art Unit: 2737

Examiner: FAILE, A.

Atty. Docket: 05634.0274

TRANSMITTAL LETTER

BOX: NON-FEE AMENDMENT

Assistant Commissioner of Patents
Washington, D.C. 20231

[X] Request for Reconsideration under 37 C.F.R. § 1.111.
[ ] Request for Extension of Time Pursuant to 37 C.F.R. § 1.136(a)
[ ] An additional claim fee is required, and is calculated as shown below:

	(Col 1) Claims Remaining After Amendment		(Col 2) Highest No. Previously Paid for	(Col 3) Present Extra	Rate	Additional Fee
Total	*1	Minus	**	=0	x $ 18.00	$0.00
Indep.	*1	Minus	***	=0	x $ 78.00	$0.00
First Presentation of Mult. Dep. Claim					x $ 260.00	$0.00
Total Additional Filing Fee for Request for Extension of Time						$0.00
Total Fee Enclosed						$0.00

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
** If the "Highest Number Previously Paid For" *in this space* is less than 20, write "20" in this space.
*** If the "Highest Number Previously Paid For" *in this space* is less than 3, write "3" in this space. "The Highest Number Previously Paid For" (Total or Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

[ ] Hunton & Williams check no. _____ in the amount of $0.00 is enclosed.
[X] The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment to Deposit Account No. 50-0206.
[x] Any filing fees under 37 CFR 1.16 for the presentation of extra claims.
[x] Any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,

Date: June 29, 2000

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